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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91164009
Party	Plaintiff BFS Brands, LLC and Bridgestone/Firestone North American Tire, LLC ,
Correspondence Address	GEOFFREY M. MCNUTT FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP 901 NEW YORK AVENUE, N.W. WASHINGTON, DC 20001-4413
Submission	Motion to Compel Discovery
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Filer's e-mail	docketing@finnegan.com, geoff.mcnutt@finnegan.com, doug.rettew@finnegan.com
Signature	/Geoffrey M. McNutt/
Date	10/14/2005
Attachments	Motion to Compel.pdf (56 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BFS BRANDS, LLC,)	
)	
and)	
)	
BRIDGESTONE/FIRESTONE, INC.)	
NORTH AMERICAN TIRE, LLC)	
)	
Opposers,)	Opposition No. 164,009
)	Serial No. 78/347,864
v.)	
)	
RUBBER KING TYRES INDIA PVT. LTD.)	
)	
Applicant.)	
_____)	

OPPOSERS' MOTION TO COMPEL

Pursuant to C.F.R. § 2.120(d)(2) and TBMP § 406.03, BFS Brands, LLC, and Bridgestone/Firestone North American Tire, LLC, (collectively "Opposers"), move the Board to compel Applicant Rubber King Tyres India Pvt. Ltd, to: (1) photocopy and mail to the offices of Opposers' counsel documents responsive to Opposers' First Requests for Production of Documents and Things; (2) include in its document production all responsive documents previously designated confidential; (3) respond fully to Interrogatory Nos. 8(d), 13, 16, and 22 in Opposers' First Set of Interrogatories.

Opposers' counsel wrote to Applicant's counsel on October 11, 2005, and called on October 14, 2005, in an attempt to resolve the issues raised in this motion. To date, Applicant's counsel has not responded.

I. Background

Opposers' First Set of Interrogatories and First Requests for Production of Documents

and Things were served on Applicant on March 30, 2005. Applicant's responses to both originally were due on May 4, 2005.

On June 21, 2005, Applicant's counsel called Opposers' counsel and left a telephone message indicating that it would be several more weeks before Applicant would respond to Opposers' discovery requests.

In a letter dated June 24, 2005, Opposers' counsel advised Applicant's counsel that Opposers would agree to extend Applicant's discovery response deadline to July 22, 2005. Exhibit A.

In an email dated June 28, 2005, Applicant's counsel indicated that Applicant would respond to Opposers' outstanding discovery requests by July 22, 2005. Exhibit B.

Applicant served its responses on July 22, 2005. Exhibits C and D, respectively. In various of those responses, Applicant raised objections based on confidentiality and/or privilege. Applicant also stated that documents in the nature of business records would be produced for inspection at the place where they typically are kept.¹ To date, Applicant has not indicated where the documents are kept.

On September 20, 2005, the parties filed an executed Stipulated Protective Order to govern the exchange of confidential information. The Stipulated Protective Order was entered by the Board on September 25, 2005, and is currently operative in this proceeding.

In a letter dated October 11, 2005, Opposers' counsel wrote Applicant's counsel to raise specific deficiencies in Applicant's discovery responses; to ascertain the location of business records responsive to Opposers' discovery requests; and to request that Applicant agree to photocopy and mail to Opposers any responsive documents located outside the United States.

¹ Applicant indicated that documents in the nature of business records would be produced for inspection at the place where they are kept, unless Opposers consented to an exchange of documents. However, Applicant's proposal became moot when Applicant did not serve any document requests on Opposers.

Exhibit E. Opposers' counsel followed up with a phone call on October 14, 2005, and left a message asking Applicant's counsel to return the call. Applicant has not responded to the October 11, 2005 letter, nor has it returned Opposers' phone call.

II. Argument

A. Applicant Should be Required to Photocopy and Mail Responsive Documents

Applicant has indicated only that the responsive business records will be produced in the place where they are kept. To date, Applicant has not provided information where the documents are located. Applicant is located in India. Absent any indication by Applicant as to where its business records are located, Opposers can only presume that the relevant documents are located in India.

Pursuant to 37 C.F.R. § 1.20(d)(2), the production of documents and things will be made at the place where the documents and things are usually kept, or where the parties agree, *or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.* (emphasis added). To this end, when a responding party unreasonably refuses to produce responsive documents, the Board may order the responding party to photocopy the documents designated in a request and mail them to the requesting party. TBMP § 406.03.

In this case, requiring Opposers to travel to India or elsewhere outside the United States to inspect and photocopy Applicant's business records is tantamount to a refusal to produce documents. Accordingly, Opposers request that the Board issue an order compelling Applicant to photocopy the documents designated in the requests and mail them to Opposers' counsel. TBMP § 406.03.

B. Applicant Must Now Produce Confidential Information

In response to Opposers' Document Request Nos. 1-6, 8-14, 18-24, 26-28, and 31,

Applicant states that “documents relating to pricing data and customer lists are considered confidential business information *and will be produced only under a Protective Order.*”

As indicated above, a Stipulated Protective Order was executed and filed on September 20, 2005, and was acknowledged by the Board on September 25, 2005. Accordingly, if the Board orders Applicant to photocopy responsive documents and mail them to Opposers’ counsel, Applicant also should be required to produce all confidential documents, including the documents relating to pricing data and customer lists.

C. Applicant Must Supply a Basis for Claiming Privilege

In its response to Interrogatory 8(d), which seeks representative customers of Applicant’s goods, Applicant makes a general assertion of privilege.

Applicant’s claim of privilege is improper because it fails to specify the basis and grounds for the asserted privilege. Moreover, information in the nature of a representative sample of Applicant’s customers is reasonably calculated to elicit evidence on the trade channels for Applicant’s products, among other things. Such information is highly relevant to the issue of likelihood of confusion. Applicant should thus be ordered to disclose the requested information.

D. Applicant Must Sufficiently Respond to Interrogatory Nos. 13, 16, and 22

Applicant’s answers to Interrogatory Nos. 13, 16, and 22 are incomplete and evasive. In response to each of these interrogatories, Applicant has provided narrowly-crafted answers that fail to fully answer the questions presented.

Interrogatory No. 13 seeks the identity of all persons and/or entities who supply or have supplied to Applicant any and all goods sold, distributed, produced, and/or offered under or in connection with Applicant’s Mark. In its answer, Applicant states that “Applicant does not procure goods from others that already bear Applicant’s mark.” The interrogatory, however, is

not limited to persons or entities who supply only goods that already bear Applicant's Mark. Rather, the interrogatory seeks the identity of persons and/or entities that manufacture goods sold, distributed, provided, and/or offered under or in connection with Applicant's Mark. On its face, the interrogatory makes no mention of when the goods were branded with the mark. The interrogatory clearly is not restricted to instances where a manufacturer applies Applicant's Mark to Applicant's goods before forwarding the goods to Applicant.

Interrogatory No. 16 seeks information about any inquires or communications relating to Opposers, Opposers' mark, Opposers' goods and/or services, and/or Opposers' businesses. Applicant's answer states that "Applicant is not aware of any inquires or communications from customers or potential customers that indicated any confusion or false affiliation with Opposers' Mark." The interrogatory is not limited to inquires and communications concerning Opposers' Mark, but also covers inquires or communications concerning Opposers' businesses, goods, and/or services. Moreover, the interrogatory is directed to all inquires or communications not just inquires or communications "that indicated any confusion or false affiliation with Opposers' Mark." Also, the interrogatory is not limited to communications from customers or prospective customers, but is sufficiently broad to cover inquiries or communications from anyone, including without limitation, dealers, distributors, and other such persons.

Interrogatory No. 22 seeks the identity of all person or entities "*involved in the manufacture distribution and/or importation* into the United States of any and all goods sold, distributed, provided, rendered, or otherwise marketed and/or offered under or in connection with Applicant's Mark." Applicant's narrowly-tailored answer states that "Applicant has not given any *authorization* to any party *to manufacture* goods using 'Rubber King' in the United States." However, the interrogatory is not limited to instances of "authorization" and is not

limited solely to the “manufacture” of Rubber King products. The interrogatory, on its face, covers the identity of all person or entities “*involved in the manufacture distribution and/or importation*” of the subject goods.

In each of these instances, Applicant has responded with a narrowly tailored answer that is improper because it is evasive and fails to fully answer the interrogatory. Applicant, therefore, should be compelled to supplement its responses with complete answers.

III. Conclusion

For the above reasons, Opposers respectfully request that the Board issue an order compelling Applicant to: (1) photocopy and mail to the offices of Opposers’ counsel documents responsive to Opposers’ Request for the Production of Documents; (2) include in its document production all confidential documents; (3) respond fully to Interrogatory Nos. 8(d), 13, 16, and 22.

WHEREFORE, favorable action on this motion is requested

October 14, 2005



Douglas A. Rettew
Geoffrey M. McNutt
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901 New York Avenue, NW
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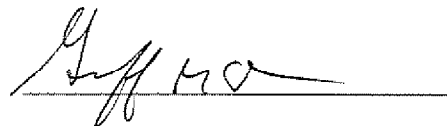
Counsel for Opposers

CERTIFICATE OF SERVICE

I hereby certify that the foregoing MOTION TO COMPEL was served on this 14th day of October, 2005, by mailing a true copy thereof to Rubber King Tyres India Pvt. Ltd.'s attorney of record via First Class U.S. Mail, postage prepaid, addressed to the following:

John Alumit, Esq.
Patel & Alumit, PC
20121 Ventura Blvd., Suite 302
Woodland Hills, CA 91364

By:

A handwritten signature in black ink, appearing to read "John Alumit", is written over a horizontal line.

OPPOSERS' MOTION TO COMPEL

Exhibit A



901 New York Avenue, NW ▪ Washington, DC 20001-4413 ▪ 202.408.4000 ▪ Fax 202.408.4400
www.finnegan.com

GEOFFREY M. McNUTT
202-408-4320
geoff.mcنutt@finnegan.com

June 24, 2005

VIA FACSIMILE AND U.S. MAIL

John Alunit, Esq.
Patel & Alunit
20121 Ventura Blvd., Suite 302
Woodland Hills, CA 91364-2559

BFS Brands and Bridgestone/Firestone v. Rubber King Tyres India
Trademark Opposition No. 91164009
Mark: RUBBER KING (Serial No. 78/347.864)

Dear Mr. Alunit:

This responds to your telephone message of June 21, 2005.

As you know, Rubber King's answers to Bridgestone/Firestone's first set of interrogatories and first request for production of documents were due on May 4, 2005. We now understand from your June 21 phone message that it will be several more weeks before Rubber King responds to our discovery requests.

Our client is willing to extend Rubber King's response deadline to July 22, 2005, provided Rubber King (1) agrees not to initiate any discovery until it has responded to our discovery requests and (2) agrees to give our clients a reciprocal extension should they require one.

Please advise us via return fax or email whether Rubber King agrees to these conditions. If Rubber King will not agree to these conditions, then we will expect to receive your client's answers to our outstanding discovery requests by next Friday, July 1, 2005.

We look forward to hearing from you.

Sincerely,

A handwritten signature in dark ink, appearing to read 'Geoffrey M. McNutt', written over a horizontal line.
Geoffrey M. McNutt

OPPOSERS' MOTION TO COMPEL

Exhibit B

McNutt, Geoff

From: Patel & Alumit, P.C. [jalumit@patelalumit.com]
Sent: Tuesday, June 28, 2005 1:33 PM
To: McNutt, Geoff
Subject: Trademark Opposition - BFS Brands v. Rubber King

Dear Mr. McNutt,

Thank you for your letter of June 24, 2005 offering to extend our response deadline to July 22, 2005 provided that Rubber King (1) agrees not to initiate any discovery until it has responded to your discovery requests and (2) agrees to give your client a reciprocal extension should you require one.

We agree to your terms, and we will respond by July 22, 2005.

Sincerely,

--

John A. Alumit

Attorney at Law

Patel & Alumit, P.C.

jalumit@patelalumit.com

www.patelalumit.com

800-973-7114

fax: 818-592-4041

intl: 818-592-4037

10/14/2005

OPPOSERS' MOTION TO COMPEL

Exhibit C

1 John Alumit, Esq.
2 Patel & Alumit, PC
3 20121 Ventura Blvd., Suite 302
4 Woodland Hills, CA 91364

5 Attorneys for Applicant

6
7 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
8 TRADEMARK TRIAL AND APPEAL BOARD
9

10 BFS Brands, LLC

) Opposition No.: 91161734

11 And

)
) **APPLICANT'S RESPONSE TO**
) **OPPOSER'S FIRST REQUEST FOR**
) **PRODUCTION OF DOCUMENTS**

12 Bridgestone/Firestone
13 North America Tire, LLC,

14 Opposer

15 vs.

16 Rubber King Tyres India Pvt. Ltd.,

17 Applicant.

18
19 PROPOUNDING PARTY: BFS Brands, LLC and

20 Bridgestone/Firestone North America Tire LLC

21 RESPONDING PARTY: Rubber King Tyres India Pvt. Ltd.

22 SET NUMBER: ONE

1 Pursuant to Federal Rules of Civil Procedure, Applicant Rubber King Tyres India Pvt.
2 Ltd. and no others hereby provide this Response to the first set of Requests for Production of
3 Documents as follows:

4 **PRELIMINARY STATEMENT**

5 Applicant's responses to this first set of Requests for Production of Documents are based
6 upon information presently known to Applicant. These responses are given without prejudice to
7 Applicant's right to supplement or amend these responses following further discovery and
8 investigation. Applicant also reserves the right to produce and use subsequently discovered
9 information in discovery, during testimony, in its briefs, and in support of or opposition to any
10 motion. Further, the fact that Applicant produces any specific document in response to these
11 Requests does not mean that Applicant consents to the authenticity or admissibility of such
12 document, nor that such document is relevant to any issue in this case.

13 **GENERAL OBJECTIONS**

14 Applicant objects to the Opposer's Requests for Production of Documents, including any
15 definitions or instructions, to the extent that they purport to require any response beyond the
16 scope of that required by the Federal Rules of Civil Procedure.

17 Applicant objects to each and every definition, instruction and request to the extent that it
18 seeks information protected by the attorney- client privilege, the attorney work product doctrine
19 or any other privilege recognized by applicable law. Without waiving and subject to such
20 objections, Applicant will produce non-privileged documents responsive to appropriate requests,
21 as indicated below.

22 Applicant objects to each and every definition, instruction and request to the extent it
23 seeks information containing trade secret or other proprietary or confidential business
24 information of Applicant, or that has been provided to Applicant subject to protection, and
25 Applicant will provide such information only pursuant to the terms of a protective order entered
26 in this case.

27 Applicant further objects to these Requests to the extent they purport to request it to
28 respond on behalf of other person(s). Applicant objects to these Requests to the extent they seek

1 information that is not reasonably calculated to lead to the discovery of admissible evidence.
2 Applicant's responses to the Requests are made on behalf of Applicant and no other.

3 The following responses are subject to the Preliminary Statement and foregoing general
4 objections, all of which are incorporated by reference in each response as if set forth in full
5 below:

6 **RESPONSES TO REQUESTS FOR PRODUCTION**

7 Request No. 1:

8 All documents or things of which identification is requested in Applicant's response to
9 Opposer's First Set of Interrogatories to Applicant

10 Response to Request No. 1:

11
12 Applicant objects to this request on the grounds that it is overbroad and unduly burdensome, and
13 seeks information which is irrelevant and not reasonably calculated to lead to the discovery of
14 admissible evidence. Except for communications protected by the attorney client privilege, and
15 without waiving its other objections, Respondent will produce the documents which are in the
16 nature of business records, pursuant to Trademark Rule 2.120(d)(2), at the place where such
17 documents are usually kept, available for inspection and copying by Petitioner, unless Petitioner
18 consents to an exchange of copies of such documents with Respondent. Documents relating to
19 pricing data and customer lists are considered confidential business information and will be
20 produced only under a Protective Order protecting the confidentiality of such documents.

21 Request No. 2:

22 All documents or things referred to, reviewed, or consulted in preparation of Applicant's
23 response to Opposer's First Set of Interrogatories to Applicant

24 Response to Request No. 2:

25
26 Applicant objects to the ambiguous terms "referred to, reviewed, or consulted." Applicant
27 objects to this request on the grounds that it is overbroad and unduly burdensome, and seeks
28 information which is irrelevant and not reasonably calculated to lead to the discovery of

1 admissible evidence. Except for communications protected by the attorney client privilege, and
2 without waiving its other objections, Respondent will produce the documents which are in the
3 nature of business records, pursuant to Trademark Rule 2.120(d)(2), at the place where such
4 documents are usually kept, available for inspection and copying by Petitioner, unless Petitioner
5 consents to an exchange of copies of such documents with Respondent. Documents relating to
6 pricing data and customer lists are considered confidential business information and will be
7 produced only under a Protective Order protecting the confidentiality of such documents.

8 Request No. 3:

9 All documents or things referring or relating to the consideration, selection or adoption of
10 Applicant's Mark.
11

12 Response to Request No. 3:

13 Applicant objects to the ambiguous terms "referring or relating to." Except for communications
14 protected by the attorney client privilege, and without waiving its other objections, Respondent
15 will produce the documents which are in the nature of business records, pursuant to Trademark
16 Rule 2.120(d)(2), at the place where such documents are usually kept, available for inspection
17 and copying by Petitioner, unless Petitioner consents to an exchange of copies of such
18 documents with Respondent. Documents relating to pricing data and customer lists are
19 considered confidential business information and will be produced only under a Protective Order
20 protecting the confidentiality of such documents.
21

22 Request No. 4:

23 All documents or things relating to the decision of Applicant to select, adopt, use and/or register
24 Applicant's Mark or any similar mark(s).
25

26 Response to Request No. 4:
27
28

1 Applicant objects to the ambiguous terms “referring to” and “any similar mark(s).” Except for
2 communications protected by the attorney client privilege, and without waiving its other
3 objections, Respondent will produce the documents which are in the nature of business records,
4 pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually kept,
5 available for inspection and copying by Petitioner, unless Petitioner consents to an exchange of
6 copies of such documents with Respondent. Documents relating to pricing data and customer
7 lists are considered confidential business information and will be produced only under a
8 Protective Order protecting the confidentiality of such documents.

9 Request No. 5:

10 All documents or things relating to any searches, search reports, and/or investigations
11 conducted by or on behalf of Applicant in connection with the selection and adoption of
12 Applicant’s Mark or any similar mark(s).
13

14 Response to Request No. 5:

15 Applicant objects to the ambiguous terms “relating to.” Except for communications protected by
16 the attorney client privilege, and without waiving its other objections, Respondent will produce
17 the documents which are in the nature of business records, pursuant to Trademark Rule
18 2.120(d)(2), at the place where such documents are usually kept, available for inspection and
19 copying by Petitioner, unless Petitioner consents to an exchange of copies of such documents
20 with Respondent. Documents relating to pricing data and customer lists are considered
21 confidential business information and will be produced only under a Protective Order protecting
22 the confidentiality of such documents. Despite the foregoing, Applicant produces a copy of the
23 search report conducted prior to filing the trademark application. Exhibit 1.
24

25 Request No. 6:
26
27
28

1 Such documents or things as will identify each and every product(s) and/or service(s)
2 currently, sold, distributed, provided, advertised or marketed under or in connection with
3 Applicant's Mark.

4 Response to Request No. 6:

5 Applicant objects to this request on the grounds that it is overbroad and unduly burdensome, and
6 seeks information which is irrelevant and not reasonably calculated to lead to the discovery of
7 admissible evidence. Except for communications protected by the attorney client privilege, and
8 without waiving its other objections, Respondent will produce the documents which are in the
9 nature of business records, pursuant to Trademark Rule 2.120(d)(2), at the place where such
10 documents are usually kept, available for inspection and copying by Petitioner, unless Petitioner
11 consents to an exchange of copies of such documents with Respondent. Documents relating to
12 pricing data and customer lists are considered confidential business information and will be
13 produced only under a Protective Order protecting the confidentiality of such documents.
14

15 Request No. 7:

16 All documents or things relating to any analysis or study done by or on behalf of
17 Applicant concerning Opposers' Marks, Opposers' Names, and/or any similar mark(s) or
18 name(s).
19

20 Response to Request No. 7:

21 Applicant objects to the ambiguous terms "any similar mark(s) or name(s)." Applicant has no
22 such documents to produce.
23

24 Request No. 8:

25 All documents or things Applicant has ever distributed or caused to be distributed under
26 Applicant's Mark, including but not limited to, the quantity of such materials distributed, the
27 date(s) on which such materials were distributed, the person(s) by whom such materials were
28

1 distributed, and the identity of the person(s) to whom such materials were distributed including,
2 but not limited to, the distributor's name, geographic location, and channel of trade.

3 Response to Request No. 8:

4 Applicant objects to this request on the grounds that it is overbroad and unduly burdensome, and
5 seeks information which is irrelevant and not reasonably calculated to lead to the discovery of
6 admissible evidence. Except for communications protected by the attorney client privilege, and
7 without waiving its other objections, Respondent will produce the documents which are in the
8 nature of business records, pursuant to Trademark Rule 2.120(d)(2), at the place where such
9 documents are usually kept, available for inspection and copying by Petitioner, unless Petitioner
10 consents to an exchange of copies of such documents with Respondent. Documents relating to
11 pricing data and customer lists are considered confidential business information and will be
12 produced only under a Protective Order protecting the confidentiality of such documents.

13 Notwithstanding the above, Applicant attaches Exhibit 2.

14
15 Request No. 9:

16 A sample of each product, tag, label, or package, bearing Applicant's Mark and sold or
17 made available to the public by Applicant or any other person or entity.

18
19 Response to Request No. 9:

20 Except for communications protected by the attorney client privilege, and without waiving its
21 other objections, Respondent will produce the documents which are in the nature of business
22 records, pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually
23 kept, available for inspection and copying by Petitioner, unless Petitioner consents to an
24 exchange of copies of such documents with Respondent. Documents relating to pricing data and
25 customer lists are considered confidential business information and will be produced only under
26 a Protective Order protecting the confidentiality of such documents. Notwithstanding the
27 foregoing, Applicant attaches one sample of one product. Exhibit 2.

1 Request No. 10:

2 A sample of each different item of advertising or promotional material bearing
3 Applicant's Mark, including but not limited to, advertisements, catalogs, circulars, leaflets,
4 brochures, bulletins, fliers, signs, sale displays, posters, promotional materials, coupons, trade
5 materials, video tapes, or other materials bearing Applicant's Mark which have been or are
6 distributed or displayed in the United States by or on behalf of Applicant.

7 Response to Request No. 10:

8
9 Except for communications protected by the attorney client privilege, and without waiving its
10 other objections, Respondent will produce the documents which are in the nature of business
11 records, pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually
12 kept, available for inspection and copying by Petitioner, unless Petitioner consents to an
13 exchange of copies of such documents with Respondent. Documents relating to pricing data and
14 customer lists are considered confidential business information and will be produced only under
15 a Protective Order protecting the confidentiality of such documents. Notwithstanding the
16 foregoing, Applicant attaches samples of the product. **Exhibit 2.**

17 Request No. 11:

18
19 All documents or things concerning any and all market tests, opinion polls, or surveys
20 Applicant has conducted, or has had conducted on its behalf, in connection with Applicant's
21 Mark, including the survey report itself, all of the back up material used in connection therewith,
22 and all completed questionnaires.

23 Response to Request No. 11:

24
25 Applicant objects to this request on the grounds that it is overbroad and unduly burdensome, and
26 seeks information which is irrelevant and not reasonably calculated to lead to the discovery of
27 admissible evidence. Documents relating to pricing data and customer lists are considered
28

1 confidential business information and will be produced only under a Protective Order protecting
2 the confidentiality of such documents.

3 No documents exist as far as the United States is concerned.

4 Request No. 12:

5
6 All documents or things relating to the total dollar amount expended by or on behalf of
7 Applicant in connection with Applicant's Mark and/or goods or services provided in connection
8 with Applicant's Mark.

9 Response to Request No. 12:

10
11 Applicant objects to the ambiguous terms "relating to." Applicant objects to this request on the
12 grounds that it is overbroad and unduly burdensome, and seeks information which is irrelevant
13 and not reasonably calculated to lead to the discovery of admissible evidence. In particular, it
14 requests information relating to amounts expended not relating to advertising or sales or any
15 other matter relating to channels of trade or fame of the mark (e.g., legal costs, research). Except
16 for communications protected by the attorney client privilege, and without waiving its other
17 objections, Respondent will produce the documents which are in the nature of business records,
18 pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually kept,
19 available for inspection and copying by Petitioner, unless Petitioner consents to an exchange of
20 copies of such documents with Respondent. Documents relating to pricing data and customer
21 lists are considered confidential business information and will be produced only under a
22 Protective Order protecting the confidentiality of such documents.

23 Request No. 13:

24
25 All documents or things relating to or showing the total sales, in both dollars and number
26 of units, of goods and/or services provided under Applicant's Mark, and when and where such
27 sales occurred.

1 Response to Request No. 13:

2 Applicant objects to the ambiguous terms "relating to." Except for communications protected by
3 the attorney client privilege, and without waiving its other objections, Respondent will produce
4 the documents which are in the nature of business records, pursuant to Trademark Rule
5 2.120(d)(2), at the place where such documents are usually kept, available for inspection and
6 copying by Petitioner, unless Petitioner consents to an exchange of copies of such documents
7 with Respondent. Documents relating to pricing data and customer lists are considered
8 confidential business information and will be produced only under a Protective Order protecting
9 the confidentiality of such documents.

10 Request No. 14:

11
12 All documents and things showing any use of Applicant's Mark, or variation thereof, on
13 goods, materials or services other than the products of Applicant.

14 Response to Request No. 14:

15
16 Applicant objects to this request on the grounds that it is overbroad and unduly burdensome, and
17 seeks information which is irrelevant and not reasonably calculated to lead to the discovery of
18 admissible evidence. Except for communications protected by the attorney client privilege, and
19 without waiving its other objections, Respondent will produce the documents which are in the
20 nature of business records, pursuant to Trademark Rule 2.120(d)(2), at the place where such
21 documents are usually kept, available for inspection and copying by Petitioner, unless Petitioner
22 consents to an exchange of copies of such documents with Respondent. Documents relating to
23 pricing data and customer lists are considered confidential business information and will be
24 produced only under a Protective Order protecting the confidentiality of such documents.

25 Request No. 15:

1 All documents or things relating or referring to any inquiries or communications from
2 customers or prospective customers which either relate to or have related to Opposers, Opposers'
3 Marks, Opposers' Names, and/or the goods, services or businesses of Opposer.

4 Response to Request No. 15:

5 Applicant objects to the ambiguous terms "relating to or referring to." Applicant has received no
6 inquiries or communications, whether orally or written, by its customers or prospective
7 customers relating to Opposer's "ROAD KING" brand.
8

9 Request No. 16:

10 All documents, correspondence or things exchanged with the Patent and Trademark
11 Office during the prosecution of any application(s) to register Applicant's Mark.
12

13 Response to Request No. 16:

14 Applicant refers to documents made available through the U.S. Patent and Trademark
15 Office's TDR (Trademark Document Retrieval) System, which may be accessed through the
16 following link: <http://portal.uspto.gov/external/portal/tow>
17

18 Request No. 17:

19 All documents and things, including but not limited to articles, reports, memoranda,
20 letters or other documents of any type under the control or in the possession of Applicant that
21 discuss or refer to Opposers, Opposers' Marks, Opposers' Names, Opposers' businesses, and/or
22 Opposers' goods and/or services.
23

24 Response to Request No. 17:

25 Applicant objects to this request on the grounds that it is overbroad and unduly burdensome, and
26 seeks information which is irrelevant and not reasonably calculated to lead to the discovery of
27 admissible evidence. Except for communications protected by the attorney client privilege, and
28

1 without waiving its other objections, Respondent will produce the documents which are in the
2 nature of business records, pursuant to Trademark Rule 2.120(d)(2), at the place where such
3 documents are usually kept, available for inspection and copying by Petitioner, unless Petitioner
4 consents to an exchange of copies of such documents with Respondent. Documents relating to
5 pricing data and customer lists are considered confidential business information and will be
6 produced only under a Protective Order protecting the confidentiality of such documents.

7 Request No. 18:

8 All documents or things concerning the consumers and/or channels of trade or
9 distribution for any product(s) and/or service(s) sold, rendered, distributed, marketed, advertised,
10 or otherwise provided under Applicant's Mark.
11

12 Response to Request No. 18:

13 Applicant objects to the ambiguous terms "concerning." Applicant objects to this request on the
14 grounds that it is overbroad and unduly burdensome, and seeks information which is irrelevant
15 and not reasonably calculated to lead to the discovery of admissible evidence. Except for
16 communications protected by the attorney client privilege, and without waiving its other
17 objections, Respondent will produce the documents which are in the nature of business records,
18 pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually kept,
19 available for inspection and copying by Petitioner, unless Petitioner consents to an exchange of
20 copies of such documents with Respondent. Documents relating to pricing data and customer
21 lists are considered confidential business information and will be produced only under a
22 Protective Order protecting the confidentiality of such documents.
23

24 Request No. 19:

25 All documents or things concerning current merchandising, advertisement and promotion
26 of goods and/or services offered under Applicant's Mark.
27

28 Response to Request No. 19:

1 Applicant objects to the ambiguous terms "concerning." Except for communications protected
2 by the attorney client privilege, and without waiving its other objections, Respondent will
3 produce the documents which are in the nature of business records, pursuant to Trademark Rule
4 2.120(d)(2), at the place where such documents are usually kept, available for inspection and
5 copying by Petitioner, unless Petitioner consents to an exchange of copies of such documents
6 with Respondent. Documents relating to pricing data and customer lists are considered
7 confidential business information and will be produced only under a Protective Order protecting
8 the confidentiality of such documents.

9 Request No. 20:

10 All correspondence between any advertising agencies or consultants and Applicant
11 relating to, or referring to, the use and/or promotion of Applicant's Mark.
12

13 Response to Request No. 20:

14 Applicant objects to the ambiguous terms "relating to, or referring to." Except for
15 communications protected by the attorney client privilege, and without waiving its other
16 objections, Respondent will produce the documents which are in the nature of business records,
17 pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually kept,
18 available for inspection and copying by Petitioner, unless Petitioner consents to an exchange of
19 copies of such documents with Respondent. Documents relating to pricing data and customer
20 lists are considered confidential business information and will be produced only under a
21 Protective Order protecting the confidentiality of such documents.
22

23 Request No. 21:

24 Each written agreement to which Applicant is a party which relates to any use,
25 promotion, and/or licensing of Applicant's Mark, including any modification of such
26 agreement(s) and all correspondence regarding such agreements and modifications thereto.
27

28 Response to Request No. 21:

1 Applicant objects to the ambiguous terms “relating to” and “regarding.” Except for
2 communications protected by the attorney client privilege, and without waiving its other
3 objections, Respondent will produce the documents which are in the nature of business records,
4 pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually kept,
5 available for inspection and copying by Petitioner, unless Petitioner consents to an exchange of
6 copies of such documents with Respondent. Documents relating to pricing data and customer
7 lists are considered confidential business information and will be produced only under a
8 Protective Order protecting the confidentiality of such documents.

9 Request No. 22:

10 To the extent not produced in response to Request No. 21, supra, all documents
11 pertaining to any other license or right granted by Applicant to a third party regarding use of
12 Applicant’s Mark, including all correspondence relating thereto.
13

14 Response to Request No. 22:

15 Applicant objects to the ambiguous terms “pertaining to.” Except for communications protected
16 by the attorney client privilege, and without waiving its other objections, Respondent will
17 produce the documents which are in the nature of business records, pursuant to Trademark Rule
18 2.120(d)(2), at the place where such documents are usually kept, available for inspection and
19 copying by Petitioner, unless Petitioner consents to an exchange of copies of such documents
20 with Respondent. Documents relating to pricing data and customer lists are considered
21 confidential business information and will be produced only under a Protective Order protecting
22 the confidentiality of such documents.
23

24 Request No. 23:

25 All documents or things relating to any investigation conducted by, or on behalf of,
26 Applicant relating to recognition of, or reaction to, any potential likelihood of confusion between
27
28

1 goods and/or services bearing or sold under Applicant's Mark and goods and/or services bearing
2 or sold under Opposer's Mark.

3 Response to Request No. 23:

4 Applicant objects to the ambiguous terms "relating to." Except for communications protected by
5 the attorney client privilege, and without waiving its other objections, Respondent will produce
6 the documents which are in the nature of business records, pursuant to Trademark Rule
7 2.120(d)(2), at the place where such documents are usually kept, available for inspection and
8 copying by Petitioner, unless Petitioner consents to an exchange of copies of such documents
9 with Respondent. Documents relating to pricing data and customer lists are considered
10 confidential business information and will be produced only under a Protective Order protecting
11 the confidentiality of such documents. Notwithstanding the foregoing, Applicant refers to
12

13 **Exhibit 1.**

14 Request No. 24:

15 All internal memoranda prepared by Applicant relating to: (a) the use of Applicant's
16 Mark; (b) any potential objections by Opposers to Applicant's use of Applicant's Mark; (c) the
17 present Opposition proceeding; and, (d) the actual objections made by Opposers to the
18 registration of Applicant's Mark.
19

20 Response to Request No. 24:

21 Applicant objects to the ambiguous terms "relating to." Except for communications protected by
22 the attorney client privilege, and without waiving its other objections, Respondent will produce
23 the documents which are in the nature of business records, pursuant to Trademark Rule
24 2.120(d)(2), at the place where such documents are usually kept, available for inspection and
25 copying by Petitioner, unless Petitioner consents to an exchange of copies of such documents
26 with Respondent. Documents relating to pricing data and customer lists are considered
27
28

1 confidential business information and will be produced only under a Protective Order protecting
2 the confidentiality of such documents.

3 Request No. 25:

4 All documents which refer to, or relate to, the circumstances surrounding Applicant
5 becoming aware of Opposers' Marks, Opposers' Names and/or Opposers' businesses.
6

7 Response to Request No. 25:

8 Applicant objects to the ambiguous terms "refer to, or relate to." Applicant has no documents
9 to produce other than the Notice of Opposition filed by Opposer and **Exhibit 1**.
10

11 Request No. 26:

12 All documents or things concerning any assignment, acquisition, purchase, or other
13 ownership transfer of any rights in Applicant's Mark.
14

15 Response to Request No. 26:

16 Applicant objects to the ambiguous terms "concerning." Except for communications protected
17 by the attorney client privilege, and without waiving its other objections, Respondent will
18 produce the documents which are in the nature of business records, pursuant to Trademark Rule
19 2.120(d)(2), at the place where such documents are usually kept, available for inspection and
20 copying by Petitioner, unless Petitioner consents to an exchange of copies of such documents
21 with Respondent. Documents relating to pricing data and customer lists are considered
22 confidential business information and will be produced only under a Protective Order protecting
23 the confidentiality of such documents.
24

25 Request No. 27:
26
27
28

1 All documents or things concerning any assertions or claims by or between Applicant and
2 any other person or entity which in any way involve, affect, or purport to affect Applicant's
3 ownership of, title to, or rights in Applicant's Mark.

4 Response to Request No. 27:

5 Applicant objects to the ambiguous terms "concerning" and "purport to affect." Except for
6 communications protected by the attorney client privilege, and without waiving its other
7 objections, Respondent will produce the documents which are in the nature of business records,
8 pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually kept,
9 available for inspection and copying by Petitioner, unless Petitioner consents to an exchange of
10 copies of such documents with Respondent. Documents relating to pricing data and customer
11 lists are considered confidential business information and will be produced only under a
12 Protective Order protecting the confidentiality of such documents.
13

14 Request No. 28:

15 All documents or things concerning any agreements between Applicant and any third
16 parties relating to the sale and/or distribution of products or provision of services under
17 Applicant's Mark.
18

19 Response to Request No. 28:

20 Applicant objects to the ambiguous terms "concerning" and "purport to affect." Except for
21 communications protected by the attorney client privilege, and without waiving its other
22 objections, Respondent will produce the documents which are in the nature of business records,
23 pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually kept,
24 available for inspection and copying by Petitioner, unless Petitioner consents to an exchange of
25 copies of such documents with Respondent. Documents relating to pricing data and customer
26 lists are considered confidential business information and will be produced only under a
27 Protective Order protecting the confidentiality of such documents.
28

1 Request No. 29:

2 All documents or things which Applicant will offer in evidence herein in support of its
3 case in this Opposition.

4 Response to Request No. 29:

5
6 Applicant has yet to determine what documents or things it will offer in evidence, and
7 thus, cannot produce responsive documents at this time.

8 Request No. 30:

9
10 For each expert Applicant intends to call to provide testimony in this proceeding:

- 11 a. any written report provided by said expert relating to the subject matter of this
12 proceeding;
- 13
14 b. a complete written statement of all opinions to be expressed by the expert in this
15 proceeding, and the basis and reasons therefore;
- 16
17 c. all documents reflecting the data or other information considered by the expert in
18 forming his/her opinion;
- 19
20 d. all exhibits to be used by the expert as a summary of or support for his/her opinions;
- 21
22 e. those documents stating the qualifications of the expert, such as would be reflected in
23 a resume, curriculum vitae, biography, summary or otherwise;
- 24
25 f. a written list of all publications authored by the witness within the last ten years;
- 26
27 g. documents reflecting the compensation to be paid for the expert's preparation time
28 and time taken to provide testimony; and
- h. a written list of any other cases in which the witness has testified as an expert at trial,
in an administrative proceeding, or by deposition within the past four (4) years.

1 Response to Request No. 30:

2 Applicant has to employ an expert, and thus cannot produce such documents at this time.

3 Request No. 31:

4
5 All documents or things not otherwise requested herein, and referred to by Applicant in
6 responding to Opposer's First Set of Interrogatories to Applicant.

7 Response to Request No. 31:

8
9 Except for communications protected by the attorney client privilege, and without waiving its
10 other objections, Respondent will produce the documents which are in the nature of business
11 records, pursuant to Trademark Rule 2.120(d)(2), at the place where such documents are usually
12 kept, available for inspection and copying by Petitioner, unless Petitioner consents to an
13 exchange of copies of such documents with Respondent. Documents relating to pricing data and
14 customer lists are considered confidential business information and will be produced only under
15 a Protective Order protecting the confidentiality of such documents.

16
17
18 Respectfully Submitted,

19
20 Dated: July 21, 2005

21 By: 

22 John Alunit
23 Patel & Alunit, PC
24 20121 Ventura Blvd., Suite 302
25 Woodland Hills, CA 91364

26
27 Attorneys for Applicant
28

OPPOSERS' MOTION TO COMPEL

Exhibit D

1 John Alunit, Esq.
2 Patel & Alunit, PC
3 20121 Ventura Blvd., Suite 302
4 Woodland Hills, CA 91364

5 Attorneys for Applicant

6
7 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
8 TRADEMARK TRIAL AND APPEAL BOARD
9

10 BFS Brands, LLC

) Opposition No.: 91161734

11 And

)
) **APPLICANT'S RESPONSE TO**
) **OPPOSER'S FIRST SET OF**
) **INTERROGATORIES**

12 Bridgestone/Firestone
13 North America Tire, LLC,

14 Opposer

15 vs.

16 Rubber King Tyres India Pvt. Ltd.,

17 Applicant.

18
19 PROPOUNDING PARTY: BFS Brands, LLC and

20 Bridgestone/Firestone North America Tire LLC

21 RESPONDING PARTY: Rubber King Tyres India Pvt. Ltd.

22 SET NUMBER: ONE

23 Applicant, Rubber King Tyres India Pvt., Ltd. (hereafter "Applicant") responds to
24 Opposers, Bridgestone/Firestone North America Tire, LLC (hereafter "Opposers")
25 Interrogatories, Set Number One as follows:
26

27 **PRELIMINARY STATEMENT AND GENERAL OBJECTIONS**
28

1 It should be noted that the responses reflect information that is presently available to and
2 specifically located by Applicant and its attorneys. Applicant reserves the right to introduce
3 additional information and documentation that may be discovered subsequent to the service of
4 these responses.

5 Each response to an individual interrogatory is subject to all appropriate objections that
6 would require the exclusion of any statement contained herein if the interrogatory were asked of
7 a witness present and testifying in court, or of any statement contained herein if the answer were
8 given by said witness. All such objections and grounds are reserved and may be imposed at the
9 time of trial.
10

11 In particular, Applicant notes that no protective order is, as yet, in place.

12 Applicant is responding in good faith to Opposer's First Set of Interrogatories as
13 Applicant interprets and understands them. If Applicant subsequently asserts an interpretation of
14 any of the interrogatories that differs from Applicant's present understanding, Applicant reserves
15 the right to supplement or modify their objections and/or responses herein.
16

17 Any document Applicant agrees to produce in response to this notice will be produced
18 solely for the purpose of this action. Each document is subject to all objections as to
19 competence, relevance, materiality, propriety and admissibility and to any and all other
20 objections on any grounds that would require the exclusion of any document at the time of trial,
21 all of which objections and grounds are expressly reserved and may be interposed at the time of
22 trial. Applicant will not re-produce responsive documents previously produced.
23

24 The fact that an individual interrogatory has been responded to should not be taken as an
25 admission or acceptance of the existence of any facts set forth or assumed by such interrogatory,
26 or that such response constitutes admissible evidence. Nor does such a statement constitute a
27 representation or admission that Applicant possesses responsive documents or information, or
28

1 that such documents or information exist at all. Rather, it means that Applicant will review or
2 produce such responsive, non-privileged, unprotected documents if they do in fact exist and are
3 found in the course of the search Applicant conducts. The fact that Applicant has produced
4 documents in response to a particular interrogatory should not be construed to a waiver by
5 Applicant of any objection to that particular interrogatory.

6
7 To the extent that any or all of the interrogatories call for documents or other information
8 prepared in anticipation of litigation or for trial, or which are otherwise protected by the work
9 product doctrine or are protected from disclosure by the attorney/client privilege or any other
10 privilege, Applicant objects to each and every such interrogatory and will not supply responses
11 or render documents protected from discovery by virtue of such doctrine or privilege. If it is
12 later discovered that a document properly protected by privilege was erroneously produced,
13 Applicant reserves the right to argue that no waiver has taken place and that the document and all
14 copies thereof must be returned.

15
16 Applicant generally objects to each and every of Opposer's interrogatories to the extent
17 that any interrogatory seeks documents and information protected by the attorney/client,
18 attorney/work product or other applicable privilege or seeks documents containing confidential
19 business information or financial information, trade secrets or other confidential and protected
20 information. Responsive documents to which no other objection is made will be produced
21 pursuant to the protective order in this case, after such protective order is entered.

22
23 Applicant generally objects to Opposers purported "definitions" and instructions
24 (incorporated from Opposer's first set of interrogatories) to the extent that those definitions or
25 instructions attempt to impose obligations beyond those imposed by the Federal Rules of Civil
26 Procedure and the court's local rules.

27 In particular, Applicant objects to Opposer's definition of "Person" as over-broad, to the
28

1 extent that it purports to include "natural persons and to corporate or other business entities,
2 whether or not in the employ of Applicant, and the acts and knowledge of a person are defined to
3 include the acts and knowledge of that person's directors, officers, members, employees,
4 representatives, agents and attorneys."

5 Applicant further objects to Opposer's definition of "trademark" as over-broad, to the
6 extent that it purports to include "service marks, collective marks, certification marks and trade
7 names."

8 Applicant further objects to Opposer's definition of "Applicant's Mark" as over-broad,
9 to the extent that it purports to include "any trademark composed in whole or in part of the term
10 "KING", and/or any trademark composed in whole or in part of any similar wording, including
11 but not limited to the trademark shown in U.S. Application Serial No. 78/347864."

12 Applicant further objects to Opposer's definition of "identify" as over-broad, to the
13 extent that it purports to include "business address... and home address."

14 The above general objections are incorporated by reference into each response below.

15 RESPONSES

16 INTERROGATORY NO. 1

17 Identify and describe in detail Applicant's businesses and corporate structure, including
18 the following:

- 19 (a) Applicant's officers, directors, managers, shareholders, and/or owners;
- 20 (b) the address and telephone number of each location at which Applicant has maintained
21 or now maintains an office or other place of business and the functions carried out at
22 each such office or place of business;
- 23 (c) the nature of Applicant's business and the period in which it has conducted such
24 business; and

1 (d) all of Applicant's subsidiaries, patents, affiliates and distributors.

2 **RESPONSE TO INTERROGATORY NO. 1**

3 Applicant objects to this interrogatory on the ground that it is burdensome and may seek
4 information containing certain confidential business secrets, proprietary information, confidential
5 and protected business information and/or information protected by the attorney/client,
6 attorney/work product or other applicable privilege.
7

8 Without waiving the foregoing objections, and subject to them, Applicant responds as
9 follows:

- 10 a) Applicant is a family owned and operated business, whose directors and shareholders are
11 the Gawarvala family.
- 12 b) Registered office of the Applicant is located at 104, Naindhara Apartment, Near GNFC
13 Info tower, S.G.Highway, Bodakdev, Ahmedabad-380054. India. Tel.No. +91-79-
14 26855619 & 0567
- 15 c) Company carries on an established business as Manufacturer & Marketers of flaps &
16 Tubes for Tyres of Automotive vehicles since 1988.
- 17 d) Applicant company has no other manufacturing facilities using the Trademark
18 "Rubber King."
19
20

21 **INTERROGATORY NO. 2**

22 Identify each and every person who participated in Applicant's decision to select, adopt
23 and/or apply to register Applicant's Mark
24

25 **RESPONSE TO INTERROGATORY NO. 2**

- 26 1) Mr.Dinesh I.Gawarvala – Director (Chairman)
- 27 2) Mr.Samir D.Gawarvala - Director
28

1 3) Design by Mr Narendra Patel of M/s Ani Media – Ahemdabad – India Qualified
2 Graduate from famous National Institute of Design – Ahmedabad who designed
3 Company's Trade Mark.

4 4) John Alumit – U.S. Trademark Attorney

5 **INTERROGATORY NO. 3**

6 Identify the person or persons in Applicant's employ most familiar with the goods with
7 which Applicant uses or intends to use Applicant's Mark, as well as the person or persons in
8 Applicant's employ most familiar with the sales, use, disposition, channels of trade and classes
9 of purchasers for Applicant's Goods.
10

11 **RESPONSE TO INTERROGATORY NO. 3**

12 Mr.Samir D.Gawarvala, Director.

13 **INTERROGATORY NO. 4**

14 Identify the person or persons in Applicant's employ most familiar with the manufacture,
15 acquisition, stocking, branding, labeling and/or marketing of goods bearing Applicant's Mark.
16

17 **RESPONSE TO INTERROGATORY NO. 4**

18 Mr.Dinesh I.Gawarvala, Director

19 **INTERROGATORY NO. 5**

20 State whether or not Applicant conducted, or caused any person to conduct on its behalf,
21 any trademark search or investigation with respect to Applicant's Mark prior to the adoption,
22 use, or application to register Applicant's Mark.
23

24 **RESPONSE TO INTERROGATORY NO. 5**

25 Applicant employed the services of the Law Office of Alex D. Patel, currently Patel &
26 Alumit, PC, to register the trademark. Attorney John Alumit recommended a search prior to
27 registration, which was conducted by Trademark Center.
28

1 **INTERROGATORY NO. 6**

2 Unless the answer to Interrogatory No. 5 is an unqualified negative, for each such search
3 or investigation, state:

- 4 (a) The date on which it was made;
- 5 (b) The name and address of the person who requested it;
- 6 (c) Whether any report was made concerning such search or investigation, and if, set out
7 verbatim the contents of, or in lieu thereof, attach to the answer to this interrogatory, a
8 copy of each said report;
- 9 (d) Identify every written communication and document concerning the search or
10 investigation..

11 **RESPONSE TO INTERROGATORY NO. 6**

- 12 (a) November 14, 2003
- 13 (b) R.S. Nasair, formerly employed by Applicant
- 14 (c) Report is attached as Exhibit One in Response to Opposers' Request for Production of
15 Documents
- 16 (d) Applicant's attorney communicated that it found no conflicts by email dated
17 November 24, 2003.

18 **INTERROGATORY NO. 7**

19 Identify and describe each and every use of the Applicant's Mark in the United States,
20 and identify and locate all documents, communications, data, and things of any kind relating to
21 the use of Applicant's Mark in the United States in connection with any goods and services.

22 **RESPONSE TO INTERROGATORY NO. 7**

23 Applicant objects to this interrogatory on the grounds that it is overbroad and seeks
24 information that is not reasonably calculated to lead to the discovery of admissible evidence.

1 Applicant objects to this interrogatory on the ground that it is burdensome and may seek
2 information containing certain confidential business secrets, proprietary information, confidential
3 and protected business information and/or information protected by the attorney/client,
4 attorney/work product or other applicable privilege.

5 Applicant further objects to this interrogatory on the ground that it is vague and
6 ambiguous, particularly with respect to the terms "of any kind, relating to."

7 Without waiving the foregoing objections, and subject to them, Applicant responds as
8 follows:
9

10 The "Rubber King" trade mark was first used in U.S.A in 1998 for Inner Tubes & Flaps
11 used in Tires for Automobile Vehicles.
12

13 **INTERROGATORY NO. 8**
14

15 To the extent not provided in the answer to the preceding Interrogatory No. 7, identify
16 and describe each and every product and/or service sold, distributed, rendered, or otherwise
17 provided by Applicant under or in connection with Applicant's Mark. With respect to all
18 product(s) and/or service(s) identified:

- 19 (a) Describe in the detail the manner in which Applicant's Mark was used;
20
21 (b) State the date of first use and the date of first use in United States commerce (if
22 different from the date of first use) of Applicant's Mark on or with each such
23 product(s) and/or service(s), and describe the circumstances of each such first use
24 and/or first use in commerce, including details of any sales, rendering, provision,
25 distributions, advertising and/or marketing involved;
26 (c) Identify (by city, county, state and country) the geographic area of distribution for the
27 goods and/or services;
28

1 (d) Identify (by name and address) representative customers of Applicant for such goods
2 and/or services;

3 (e) Identify and describe the class(es) of purchasers, consumers, and ultimate users of
4 such goods or services;

5 (f) Describe the channels of trade by which such goods reach the intended class(es) of
6 purchasers, consumers and/or ultimate users;
7

8 **RESPONSE TO INTERROGATORY NO. 8**

9 Applicant objects to this interrogatory on the grounds that it is overbroad and seeks
10 information that is not reasonably calculated to lead to the discovery of admissible evidence.

11 Applicant objects to this interrogatory on the ground that it is burdensome and may seek
12 information containing certain confidential business secrets, proprietary information, confidential
13 and protected business information and/or information protected by the attorney/client,
14 attorney/work product or other applicable privilege.
15

16 Without waiving the foregoing objections, and subject to them, Applicant responds as
17 follows:

18 (a) Embossing/Printing of the trade mark on the product manufactured & also printing of
19 trade mark on packing material in which goods are packed.
20

21
22 (b) Trademark was first used in India on January 1993, and in commerce in India on
23 November 2, 1993. In international markets, the trademark was first used on November
24 25, 1995, and in the U.S. on February 10, 1998.

25 (c) USA, Europe, Singapore, Philippines, Bangladesh, Sri Lanka, Africa, Latin American
26 Countries & the Middle east

27 (d) [Privilege claimed]
28

1 (e) Ultimate consumers are persons seeking to install applicant's goods in automobile tires, in
2 particular, users, manufacturers, or sellers of heavy buses and cars, including the Defense
3 Services, State Transportation Departments and local Replacement markets.

4 (f) Applicant is directly selling products to the customer by Contacting them in person or by
5 communication from India to the USA. Applicant also has a website at
6 www.rubberking.net.
7

8 **INTERROGATORY NO. 9**

9 For each and all goods and services identified in answer to Interrogatory No. 8, state the
10 value and quantity of sales of such goods and/or services annually, by dollars and by unit, for
11 each year since the date of Applicant's first use of Applicant's Mark.

12 **RESPONSE TO INTERROGATORY NO. 9**

13 Applicant objects to this interrogatory on the grounds that it is overbroad and seeks
14 information that is not reasonably calculated to lead to the discovery of admissible evidence.

15
16 Applicant objects to this interrogatory on the ground that it is burdensome and may seek
17 information containing certain confidential business secrets, proprietary information, confidential
18 and protected business information and/or information protected by the attorney/client,
19 attorney/work product or other applicable privilege.

20 Without waiving the foregoing objections, and subject to them, Applicant responds as
21 follows:
22

23 1) Between December 10, 1998 and January 5, 2004, the value of goods supplied in the U.S.
24 was less than USD 1.85 million for approximately 350,000 pieces.

25
26 2) Between January 5, 2004 and June 30, 2005, approximately USD .5 million for
27 approximately 95,000 pieces.
28

1 **INTERROGATORY NO. 10**

2 For each and all goods and services identified in answer to Interrogatory No. 8, state
3 whether use of Applicant's Mark in commerce has ever been discontinued for any period of time
4 since its initial use in the United States and, if so,

5 (a) Specify the date and duration of such discontinuance;

6 (b) Specify the goods and/or services for which use of Applicant's Mark was
7 discontinued;

8 (c) Specify the reasons for such discontinuance; and

9 (d) Identify and locate all documents and/or data that refer to or relate to such
10 discontinuance.
11

12 **RESPONSE TO INTERROGATORY NO. 10**

13 Use in commerce of Applicant's Mark has never been discontinued in the U.S.
14

15 **INTERROGATORY NO. 11**

16 State the amount of money Applicant has spent on advertising and sales promotion of any
17 and all goods and/or services sold and/or offered under or in connection with Applicant's Mark
18 for each year and by various media.

19 **RESPONSE TO INTERROGATORY NO. 11**

20 Applicant objects to this interrogatory on the grounds that it is overbroad and seeks
21 information that is not reasonably calculated to lead to the discovery of admissible evidence.
22

23 Applicant objects to this interrogatory on the ground that it is burdensome and may seek
24 information containing certain confidential business secrets, proprietary information, confidential
25 and protected business information and/or information protected by the attorney/client,
26 attorney/work product or other applicable privilege.

27 Applicant further objects to this interrogatory on the ground that it is vague and
28

1 ambiguous, particularly with respect to the terms "in connection with" and "various media."

2 Without waiving the foregoing objections, and subject to them, Applicant responds as
3 follows: To date, Applicant has spent as follows:

- 4 (a) \$50,000 – brochures and samples, including courier charge, business cards,
5 transportation costs for direct solicitations
- 6 (b) \$10,000 – Exhibition panels and travel costs
- 7 (c) \$5,000 – Web design

8
9 **INTERROGATORY NO. 12**

10 Identify each item of advertising and promotional material, documents or thing bearing
11 Applicant's Mark, including advertisements, catalogs, circulars, leaflets, brochures, bulletins,
12 fliers, signs, sales displays, posters, promotional materials, coupons, trade materials; Internet
13 materials; and other materials bearing the Applicant's Mark which have been or are currently
14 distributed or displayed in the United States by or on behalf of Applicant; and;

- 15 (a) State the dates on which they were distributed or displayed;
- 16 (b) State the manner and/or publication(s) in which they were distributed or displayed;
- 17 (c) State the geographic area (by city, county and state) where said items or copies
18 thereof were distributed or displayed by or on behalf of Applicant.

19
20 **RESPONSE TO INTERROGATORY NO. 12**

21 Applicant objects to this interrogatory on the grounds that it is overbroad and seeks
22 information that is not reasonably calculated to lead to the discovery of admissible evidence.

23
24 Applicant objects to this interrogatory on the ground that it may seek information which
25 consists of confidential business secrets, proprietary information, confidential and protected
26 business information and/or information protected by the attorney/client, attorney/work product
27 or other applicable privilege.
28

1 Without waiving the foregoing objections, and subject to them, Applicant responds as
2 follows: Catalogues/brochures are printed in India and sent to prospective buyers in the U.S., a
3 copy of which was produced in Exhibit Two of Applicant's Response to Opposers' First Request
4 for Production of Documents.

5 **INTERROGATORY NO. 13**

6 For any and all goods sold, distributed provided and/or offered under or in connection
7 with Applicant's Mark, identify (by full name, street address, city, state, and country) all persons
8 and/or entities who supply or have supplied any such goods to Applicant, and identify the
9 manufacturer of such goods.
10

11 **RESPONSE TO INTERROGATORY NO. 13**

12 Applicant objects to this interrogatory on the grounds that it is overbroad and seeks
13 information that is not reasonably calculated to lead to the discovery of admissible evidence.
14

15 Applicant objects to this interrogatory on the ground that it may seek information which
16 consists of confidential business secrets, proprietary information, confidential and protected
17 business information and/or information protected by the attorney/client, attorney/work product
18 or other applicable privilege.

19 Without waiving the foregoing objections, and subject to them, Applicant responds as
20 follows: Applicant does not procure goods from others that already bear Applicant's Mark.
21

22 **INTERROGATORY NO. 14**

23 Identify (by full name, street address, city, state and country) all persons and/or entities
24 who participate in or have participated in branding, marking, and/or labeling goods with
25 Applicant's Mark.

26 **RESPONSE TO INTERROGATORY NO. 14**

27 Applicant objects to this interrogatory on the grounds that it is overbroad and seeks
28

1 information that is not reasonably calculated to lead to the discovery of admissible evidence.

2 Without waiving the foregoing objections, and subject to them, Applicant responds as
3 follows: The primary persons who participated in the selection and adoption of Applicant's
4 Mark are identified in Response to Interrogatory No. 2.

5 **INTERROGATORY NO. 15**

6 Describe in detail the circumstances by which Applicant first became aware of Opposers'
7 Mark, including but not limited to when and how Applicant first became aware of Opposers'
8 Mark.
9

10 **RESPONSE TO INTERROGATORY NO. 15**

11 While Opposers' Mark was one of hundreds listed in a search report delivered to
12 Applicant on November 14, 2003, Applicant did not become aware of Opposers' Mark until it
13 received the Notice of Opposition on February 4, 2005.
14

15 **INTERROGATORY NO. 16**

16 If Applicant or its agents, dealers, affiliates, or licensees is aware of any inquiries or
17 communications from customers or prospective customers which either relate to or have related
18 to Opposers, Opposers' Mark, Opposers' Goods and/or Services, and/or the businesses of
19 Opposers, then state:

- 20 (a) The date upon which each such inquiry or communication became known to
21 Applicant;
22
23 (b) The source of each such inquiry or communication;
24
25 (c) The manner in which such inquiry or communication was made to Applicant;
26
27 (d) The substance of each such inquiry or communication; and
28
29 (e) Identify each and every oral inquiry or communication, and each and every
written communication relating to, responding to, connected with or arising

1 out of such inquiry or communication and state verbatim the contents of the
2 documents, or in lieu thereof, attach a true and complete copy of the
3 documents as an exhibit to the answers to these interrogatories.

4 **RESPONSE TO INTERROGATORY NO. 16**

5 Applicant objects to this interrogatory on the grounds that it is overbroad and seeks
6 information that is not reasonably calculated to lead to the discovery of admissible evidence.
7

8 Applicant objects to this interrogatory on the ground that it may seek information which
9 consists of confidential business secrets, proprietary information, confidential and protected
10 business information and/or information protected by the attorney/client, attorney/work product
11 or other applicable privilege.

12 Applicant further objects to this interrogatory on the ground that it is vague and
13 ambiguous, particularly with respect to the terms "relate to, and have related to."
14

15 Without waiving the foregoing objections, and subject to them, Applicant responds as
16 follows: Applicant is not aware of any inquiries or communications from customers or
17 prospective customers that indicated any confusion or false affiliation with Opposers' Mark.

18 **INTERROGATORY NO. 17**

19 If Applicant or its agents, dealers, affiliates, or licensees is aware of any instance in
20 which a person has been confused, mistaken or deceived as to the source of Applicant's Goods
21 and/or Services or as to any affiliation or connection between Applicant and Opposers, then for
22 each such instance state and/or identify:
23

24 (a) Each person with knowledge of each instance of such confusion, mistake or
25 deception; and

26 (b) Each document and/or oral communication relating to said confusion, mistake
27 or deception.
28

1 **RESPONSE TO INTERROGATORY NO. 17**

2 Applicant objects to this interrogatory on the ground that it is burdensome and may seek
3 information containing certain confidential business secrets, proprietary information, confidential
4 and protected business information and/or information protected by the attorney/client,
5 attorney/work product or other applicable privilege.
6

7 Without waiving the foregoing objection, and subject to it, Applicant responds as
8 follows: Applicant is unaware of any instance in which a person has been confused, mistaken or
9 deceived as to the source of Applicant's Goods and/or Services or as to any affiliation or
10 connection between Applicant and Opposers.

11 **INTERROGATORY NO. 18**

12 Identify each and every medium/media in which Applicant has advertised goods and or
13 services under the Applicant's Mark, and:
14

- 15 (a) State the dates on which the advertising took place;
16 (b) For print advertisements, identify the publication in which such advertisements
17 appeared.

18 **RESPONSE TO INTERROGATORY NO. 18**

19 Applicant does not advertise in print advertisements, but conducts direct solicitations.
20 Applicant's website went live on January 23, 2001. Applicant participated in the SEMA
21 tradeshow in Las Vegas in November 2004.
22

23 **INTERROGATORY NO. 19**

24 Identify each person and/or entity, including but not limited to any advertising agency,
25 market research firm, or public relations firm, which has rendered services to Applicant in
26 connection with advertising or promoting goods and/or services bearing Applicant's Mark; and
27 for each such person or entity:
28

- 1 (a) State the nature of the services performed;
- 2 (b) State the dates on which or during which such services were performed;
- 3 (c) Identify each person who participated in the performance of such services;
- 4 (d) State the cost of such services to the Applicant.

5 **RESPONSE TO INTERROGATORY NO. 19**

6 Applicant has employed no one to assist in advertising or promoting its goods in the

7 United States, other than the creation of a website designed by M/s Animedia of India. See

8 Response to Interrogatories 11 and 18.

9 **INTERROGATORY NO. 20**

10 Identify all related companies of Applicant (as the term "related company" is defined in

11 15 U.S.C. § 1127).

12 **RESPONSE TO INTERROGATORY NO. 20**

13 Applicant has no "related company."

14 **INTERROGATORY NO. 21**

15 Identify all persons and/or parties that Applicant has licensed or otherwise authorized to

16 use Applicant's Mark in connection with the manufacture, distribution, sale, provision, offering,

17 advertisement, marketing or promotion of any goods and/or services, and identify and locate any

18 and all agreements, including without limitation any licenses, assignments, permissions, or

19 consents, relating thereto.

20 **RESPONSE TO INTERROGATORY NO. 21**

21 Applicant has not given any license or authorization to anyone, anywhere in the world to

22 use applicant's "Rubber King" trade mark.

23 **INTERROGATORY NO. 22**

24 Identify any and all persons or parties, other than Applicant, involved in the manufacture,

25

26

27

28

1 distribution and/or importation into the United States, of any and all goods and/or services sold,
2 distributed, provided, rendered, or otherwise marketed and/or offered under or in connection
3 with Applicant's Mark.

4 **RESPONSE TO INTERROGATORY NO. 22**

5 Applicant objects to this interrogatory on the grounds that it is overbroad and seeks
6 information that is not reasonably calculated to lead to the discovery of admissible evidence.
7

8 Applicant objects to this interrogatory on the ground that it may seek information which
9 consists of confidential business secrets, proprietary information, confidential and protected
10 business information and/or information protected by the attorney/client, attorney/work product
11 or other applicable privilege.

12 Without waiving the foregoing objections, and subject to them, Applicant responds as
13 follows: Applicant has not given any authorization to any party to manufacture goods using
14 "Rubber King" in the United States..
15

16 **INTERROGATORY NO. 23**

17 Identify, by name and title, each person you expect to call as a witness in this opposition,
18 and state the subject matter on which the witness is expected to testify.

19 **RESPONSE TO INTERROGATORY NO. 23**

20 Applicant has not yet determined which witness will testify and to what subject matter.
21

22 **INTERROGATORY NO. 24**

23 Identify, by name and title, each person you expect to call as an expert witness in this
24 opposition and state separately with respect to each such person:

- 25 a. the subject matter on which the expert is expected to testify;
26 b. the substance of the facts and opinions to which the expert is expected to testify; and
27 c. a summary of the goods for each such opinion
28

1 **RESPONSE TO INTERROGATORY NO. 24**

2 Applicant has not yet determined what expert witness will testify and to what subject matter

3 **INTERROGATORY NO. 25**

4 Identify each and every person who has participated in responding to these
5 interrogatories, and/or Opposer's First Request for Production of Documents and Things to
6 Applicant. If more than one person participated in answering, state which person(s) is (are)
7 answering each interrogatory.
8

9 **RESPONSE TO INTERROGATORY NO. 25**

10 Dinesh I.Gawarvala participated in answering as far as the facts are concerned. John
11 Alunit participated in answering as far as the trademark search and legal objections are
12 concerned..
13

14 Dated July 22, 2005

15 By: 

16 John Alunit
17 Patel & Alunit, PC
18 Attorneys for Applicant
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing APPLICANT'S RESPONSE TO OPPOSER'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS was served on Opposers this 22nd day of July 2005, by mailing a true copy thereof via First Class U.S. Mail, postage prepaid, addressed to the following:

Geoffrey M. McNutt
Finnegan Henderson Farabow Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001-4413

 c 7/22/05

OPPOSERS' MOTION TO COMPEL

Exhibit E



901 New York Avenue, NW ▪ Washington, DC 20001-4413 ▪ 202.408.4000 ▪ Fax 202.408.4400
www.finnegan.com

GEOFFREY M. McNUTT
202.408.4320
geoff.mcnett@finnegan.com

October 11, 2005

John A. Alumit, Esq.
Law Offices of Alex D. Patel
20121 Ventura Blvd., Ste. 302
Woodland Hills, CA 91364

VIA EMAIL, FACSIMILE, AND U.S. MAIL

BFS Brands, LLC, and Bridgestone/Firestone North American Tire, LLC,
v. Rubber King Tyres India Pvt. Ltd.
Opposition No. 91164009
Mark: RUBBER KING, SN 78/347,864

Dear Mr. Alumit:

We write to address various deficiencies in Applicant's responses to Opposers' discovery requests. These deficiencies are outlined below.

Interrogatory No. 8(d)

In its response to Interrogatory 8(d), which seeks the identity of representative customers of Applicant's goods, Applicant makes a general assertion of privilege.

This claim of privilege is improper because it fails to specify the basis and grounds for the asserted privilege. Moreover, Opposers are entitled to discovery of a representative sample of Applicant's customers in order to ascertain the trade channels for Applicant's products. As you know, an inquiry into the parties' respective trade channels is essential to the Board's likelihood-of-confusion analysis.

Interrogatory No. 13

Interrogatory No. 13 seeks the identity of all persons and/or entities who supply or have supplied to Applicant any and all goods sold, distributed, produced, and/or offered under or in connection with Applicant's Mark. In its answer, Applicant states that "Applicant does not procure goods from others that already bear Applicant's mark."

Applicant's answer is incomplete, evasive, and potentially misleading. The interrogatory is not limited to persons or entities who supply only goods that already bear Applicant's Mark. Rather, the interrogatory seeks the identity of persons and/or entities that manufacture goods

sold, distributed, provided, and/or offered under or in connection with Applicant's Mark. On its face, the interrogatory makes no mention of when the goods were branded with the mark. The interrogatory clearly is not restricted to instances where a manufacturer applies Applicant's Mark to Applicant's goods prior to forwarding the goods to Applicant.

Interrogatory No. 16

Interrogatory No. 16 seeks information about any inquires or communications relating to Opposers, Opposers' mark, Opposers' goods and/or services, and/or Opposers' businesses. Applicant's answer states that "Applicant is not aware of any inquires or communications from customers or potential customers that indicated any confusion or false affiliation with Opposers' Mark."

The interrogatory is not limited to inquires and communications concerning Opposers' Mark, but also covers inquires or communications concerning Opposers' businesses, goods, and/or services. Moreover, the interrogatory is directed to all inquires or communications not just inquires or communications "that indicated any confusion or false affiliation with Opposers' Mark." Also, the interrogatory is not limited to communications from customers or prospective customers, but is sufficiently broad to cover inquiries or communications from anyone, including without limitation, dealers, distributors, and other such persons.

Applicant's narrowly-tailored answer is improper because it is evasive and fails to fully answer the interrogatory.

Interrogatory No. 22

Interrogatory No. 22 seeks the identity of all person or entities "*involved in the manufacture distribution and/or importation* into the United States of any and all goods sold, distributed, provided, rendered, or otherwise marketed and/or offered under or in connection with Applicant's Mark." Applicant's narrowly-tailored answer states that "Applicant has not given any *authorization* to any party to *manufacture* goods using 'Rubber King' in the United States." However, the interrogatory is not limited to instances of "authorization" and is not limited solely to the "manufacture" of Rubber King products. The interrogatory, on its face, covers the identity of all person or entities "*involved in the manufacture distribution and/or importation*" of the subject goods.

Applicant's narrowly-tailored answer is improper because it is evasive and fails to fully answer the interrogatory.

Document Request Nos. 1-6, 8-14, 18-24, 26-28, and 31.

In response to Document Request Nos. 1-6, 8-14, 18-24, 26-28, and 31, Applicant states that "documents relating to pricing data and customer lists are considered confidential business information and will be produced only under a Protective Order protecting the confidentiality of such documents." Now that the Stipulated Protective Order is in place, we expect Applicant to


produce the pricing data, customer lists, and any other confidential documents responsive to Opposers' discovery requests that have been withheld pending entry of a protective order.

With respect to the location and manner of Applicant's document production, you indicate that responsive business records will be produced in the place where they are kept. Please advise where the documents are kept and the number of documents contained in the production. If the documents are located in the United States, we intend to send someone to copy them this week.

If the documents are located outside the United States, then we ask that you photocopy the documents and forward them to us. Absence your assurance by Friday, October 14, 2005, that the documents will be copied and sent to us, we will have to file a motion pursuant to 37 C.F.R. § 2.120(d)(2) and TBMP § 406.03 seeking a Board order compelling your client to photocopy and forward all responsive documents. Forcing us to travel to India or elsewhere outside the United States would, in effect, constitute an unreasonable refusal to produce the documents.

Please contact us as soon as possible, and no later than October 13, 2005, to resolve these issues.

Sincerely,



Geoffrey M. McNutt

cc: Douglas A. Rettew, Esq. (Finnegan Henderson)